

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

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UNITED STATES PATENT AND TRADEMARK OFFICE

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIE ANGELOPOULOS, YUN-HSIN LIAO
and RAVI F. SARAF

Appeal No. 2002-0906
Application 09/346,353¹

ON BRIEF

Before KIMLIN, METZ and KRATZ, *Administrative Patent Judges.*

METZ, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 16, 20, 22 through 25 and 40 through 42. Claims 17 through 19, 21, 26 through 39 and 43 through 45, the only other claims remaining in this application, are claims directed to a previously non-elected invention and,

¹ Application for patent filed July 2, 1999. According to the official records of the Patent and Trademark Office (PTO) this application is division of application Serial Number 08/620,631, filed on March 22, 1996, and now U.S. Patent Number 5,969,024, issued on October 19, 1999.

accordingly, form no issue in this appeal. 37 C.F.R. § 1.142(b).

THE INVENTION

The appealed subject matter is directed to a method for preparing crystalline electrically conductive polymers or electrically conductive polymer precursors. The method comprises forming an admixture of a solvent, an additive and a precursor to an electrically conductive polymer or an electrically conductive polymer and thereafter removing or partly removing the solvent leaving the additive in combination with the polymer or the precursor to the polymer. According to appellants, their method enables the skilled polymer chemist to tailor the physical, mechanical and electrical properties of the polymers.

Claim 1 is believed to be adequately representative of the appealed subject matter and is reproduced below for a more facile understanding of the claimed invention:

Claim 1. A method comprising:

forming an admixture of a solvent, an additive and a polymer selected from the group consisting of a precursor to an electrically conductive polymer and an electrically conductive polymer said polymer being soluble in said solvent said polymer not being substantially soluble in said additive in the absence of said solvent;

said additive provides local mobility to said polymer to allow said polymer to associate with one another to achieve a crystalline state; and

removing or partly removing said solvent substantially leaving said additive therein as remaining additive, said remaining additive provides local mobility to said polymer to achieve said crystalline state.

THE REFERENCES

The references of record which are being relied on as evidence of lack of novelty and as evidence of obviousness are:

Han	5,171,478	December 15, 1992
Cao et al. (Cao)	5,232,631	August 3, 1993
Ikkala et al. (Ikkala)	5,520,852	May 28, 1996
Angelopoulos et al.	5,969,024	October 19, 1999

Han is directed to a method for preparing and using conductive and non-conductive polymers (column 1, lines 16 through 20). Han discloses a method for coupling or crosslinking neutral or electrically conductive polyaniline by heating a composition comprising polyaniline for a time sufficient to increase the molecular weight of the polyaniline (column 3, lines 40 through 47). The polyaniline may be used neat and in either the molten or solid state and it may be used as a blend with other electrically conductive or neutral thermoplastic or thermosetting polymers (column 4, lines 53 through 60). The polyaniline may be in a solution, for example, as described in U.S. Patent Number 4,983,322 (column 4, lines 62 through 64). Han discovered that shorter heating times could be employed if the polyaniline includes a "plasticizing agent" or if the heating step is carried out in the presence of a "plasticizing agent" (column 6, lines 21 through 45; claims 32 and 33). Useful "plasticizing" agents include water, alcohol, benzene, N,N-dimethylformamide, N-methyl pyrrolidinone, esters of aliphatic acids such as butyl laurate, ethyl octoate, butyl stearate,

glycols, aromatic and aliphatic sulfonic acids and many others (column 6, line 46 through column 7, line 46). Preferred, more preferred and most preferred plasticizers are also described (column 7, lines 47 through 66). Useful polyanilines include emeraldine (column 9, lines 5 through 22). The polyanilines are prepared by conventional methods and may be neutral or electrically conductive (column 14, line 19 through column 22, line 10). The polyaniline may include other additives (column 22, lines 11 through 37). When a solution of polyaniline is formed, partial or substantial removal of the solvent occurs prior to use (column 23, lines 2 through 6). In example 6, Han describes forming an admixture of a polyaniline, N-methyl pyrrolidinone and tripropylamine. The solution was transformed into a gel and then spun into a conductive fiber (column 25, lines 44 through 59).

Cao discloses the use of functionalized protonic acids to induce processability of electrically conductive polyanilines in organic liquids or melts (column 1, lines 6 through 13). Cao discloses solutions and plasticized polymeric compositions of polyaniline of film- and fiber-forming molecular weight, a solvent or plasticizing liquid and a functionalized protonic acid solute (column 3, line 63 through column 4, line 16). Cao prepares their compositions by forming a solution of polyaniline, a solvent and a functionalized protonic acid solute and then removing all or a portion of the solvent (column 4, lines 27

through 33; column 6, lines 16 through 29). The functionalized protonic acid solute imparts conductivity to the polyaniline (column 10, lines 45 through 53). Useful functionalized protonic acid solutes include sulfonic and carboxylic acids (column 10, line 45 through column 11, line 28). The amount of functionalized protonic acid solute added depends on the degree of conductivity desired (column 12, lines 52 through 55). Useful solvents include benzene, toluene and xylene (column 13, line 36 through column 14, line 48). Cao discloses combining solid polyaniline powder, xylene and dodecylbenzene sulfonic acid (column 15, lines 48 through 59; Example 3, column 18, lines 34 through 39). After forming the compositions, their physical properties may be enhanced by drawing or otherwise distorting them (column 16, lines 24 through 29). Solvent is removed from the composition by any conventional solvent removal method but, preferably, by evaporation (column 16, lines 30 through 34).

Ikkala discloses electrically conductive polyaniline compositions and methods for their preparation (column 1, lines 8 through 14). The compositions typically comprise: an electrically conductive polyaniline polymer, copolymer salt or mixtures thereof; at least one organic cyclic compound capable of forming ring-ring interactions with the 6-membered rings of the polyaniline; at least one surfactant phase; and, optionally, at least one organic substrate phase (column 6, line 44 through

column 7, line 24). One component is an electrically conductive polyaniline and includes both polyaniline doped with sulfonic acid and non-conducting polyaniline which is subsequently protonated with a strong protonic acid (column 7, line 65 through column 8, line 50). The organic cyclic compound, working with the surfactant, acts as a "solvent-plasticizer" of the conductive polyaniline. When the organic cyclic compound is a molecular recognition compound it acts in combination with the surfactant to dissolve the polyaniline doped with sulfonic acid and form strong molecular associations with the polyanilines (column 10, lines 12 through 23; lines 28 through 34). The molecular recognition compound also acts as a compatibilizer by improving the interaction between the various phases of the composition (column 10, line 35 through column 11, line 10). The surfactants may be anionic, cationic, nonionic or amphoteric and include phosphate esters and phosphonates (column 14, line 45 through column 15, line 50). Other optional ingredients may be included in the composition (column 17, lines 21 through 28). The process for preparing the compositions comprises admixing a protonated polyaniline polymer with a surfactant and a cyclic organic ring compound (column 17, lines 31 through 37). The compositions are formed by standard polymer processing operations such as solution blending (column 17, lines 38 through 43). Films can be cast from the solutions (column 17, lines 50 through 53). The solubility of

the electrically conductive polyaniline in the organic compound/surfactant was determined and if a homogeneous, one-phase sample was obtained the organic compound/surfactant was classified as a solvent for the polyaniline (column 18, lines 48 through 54).

THE REJECTIONS

Claims 1 through 16, 20, 22, 23 and 25 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 and 2 of Angelopoulos et al. Claims 24 and 40 through 42 stand rejected under 35 U.S.C. 112, first paragraph, as the subject matter claimed therein is not "described" in appellants' original disclosure. Claim 1 through 16, 20, 22, 23 and 25 stand rejected as unpatentable under 35 U.S.C. § 102 as "anticipated" by Han, Ikkala or Cao or, alternatively, as unpatentable under 35 U.S.C. § 103 because the subject matter claimed therein would have been obvious to a person of ordinary skill in the art at the time appellants made their invention from Han, Ikkala or Cao.

OPINION

Appellants have failed to argue with any reasonable degree of specificity the patentability of any dependent claim. Rather, at page 4 of their brief appellants state:

Claims 1, 7, 11 and 12 are the independent and therefore broadest claims in the instant application. The remaining claims are all dependent claims. These are the main claims for consideration in this appeal. Claims 1, 7 and 12 cover

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methods of forming different embodiments and Claim 11 is a method of forming a specific composition. The consideration of Claim 1 should be the main focus in this appeal as Claims 7, 11 and 12 are variations of the method found in Claim 1. They should be considered after Claim 1 is evaluated.

In the first instance, in rendering our decision in this appeal we shall carefully consider every claim before us. Nevertheless, we can only consider the arguments which appellants actually raise in their brief after we evaluate the claims on appeal, the prior art and the examiner's stated rejections. The "grouping of claims" requirement of 37 C.F.R. § 1.192 was not intended to be and is not a substitute for actual arguments in the brief which explain appellants' reasons for why the examiner's rejection should be reversed. Except for appellants' arguments found on page 6 of their brief with respect to independent claim 11, there are no separate arguments advanced in appellants' brief addressing particular limitations in particular claims. Therefore, except for claim 11, we shall decide this appeal based on the patentability of independent claim 1. See 37 C.F.R. § 1.192 (c) (7), first sentence. In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642 (Fed. Cir. 1986).

We begin by determining the scope and content of appellants' claims because it is the claims which define the protection for which appellants seek a patent. Claim 1 is recited to be a method which "comprises" forming an admixture of "a solvent", "an

additive" and a "polymer" which is either a "precursor to an electrically conductive polymer" or "an electrically conductive polymer", *per se*. After forming the admixture, the solvent is removed or partly removed "substantially leaving said additive therein as remaining additive." As a "comprising" claim, claim 1 requires the recited steps but does not exclude any other steps disclosed in the prior art, including both those disclosed but not claimed by appellant and those neither disclosed nor contemplated by appellant. In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 802 (CCPA 1981).

The language in claim 1 further describes the "solvent" as one in which the "polymer" is soluble and which also solubilizes the combination of the "polymer" and the "additive." At page 11 of appellants' specification, useful organic and aqueous solvents are disclosed as useful "solvents". At pages 9, 12, 16 and 17 of the specification, appellants disclose that plasticizers are useful "additives" in the method claimed in claim 1. At page 9 of the specification, a plasticizer is defined as:

a substance which when added to a polymer, solvates the polymer and increases its flexibility, deformability, generally increases the glass transition temperature T_g , and generally reduces the tensile modulus.

At page 9, lines 10 through 13 of the specification, appellants describe "electrically conducting polymer precursors as "[t]he non-doped form of polyaniline and the non-doped form of the other

conducting polymers."

The last step of the method of claim 1 requires that the "solvent" is removed or partially removed. Appellants' examples disclose spin coating films and solution casting films with admixtures prepared by the process of claim 1. Those techniques would be expected to at least partially remove the solvent in the "admixture." Nevertheless, because there is no specific description in the specification for how appellants remove or partially remove² the "solvent" from the "admixture", we shall give those terms their ordinary meaning. Thus, claim 1 requires removing all or less than all of the solvent from the admixture of "solvent", "additive" and "polymer."

The recitations in claim 1 that by performing the claimed method steps the "additive provides local mobility to said polymer ..." are not understood to be further limitations of the method steps recited. Rather, we consider those recitations to be descriptions of the properties imparted to the intermediate and final product obtained by the claimed steps of "forming an admixture" and "removing or partly removing said solvent" from the admixture.

² When a term of degree is used to describe a claim element we must look to the specification and determine whether the specification provides some standard for measuring that term of degree. Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573, 574 (Fed. Cir. 1984).

THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION

Appellants have made no argument concerning the merits of the examiner's rejection of the claims on the grounds of the judicially created obviousness-type double patenting rejection. Indeed, appellants have not even listed the rejection in their statement of the issues on page 4 of their brief. Rather, during the prosecution before the examiner appellants have expressed their willingness to file the requisite terminal disclaimer some time later in the prosecution of this application. In his answer, the examiner directs our attention to Paper Number 10 for appellants' statement of their intention to file the necessary terminal disclaimer "when claims are found allowable herein." Accordingly, we summarily affirm the rejection of claims 1 through 16, 20, 22, 23 and 25 on the grounds of obviousness-type double patenting over claims 1 and 2 in U.S. Patent Number 5,969,024.

THE REJECTION UNDER 35 U.S.C. § 112

As the court made clear in its decision in In re Rasmussen, 650 F.2d 1212, 1214, 1215, 211 USPQ 323, 325, 326 (CCPA 1981), Section 132 of Title 35 prohibits the introduction of "new matter" into the disclosure of an application. Thus, the examiner's objection to language inserted into the claims after appellants filed their application does not properly state the question before us. The question to be decided is does

appellants' original disclosure describe, in the sense of the statute, the invention which appellants now claim. Section 112, first paragraph, of Title 35 requires that claim language be both described and enabled in the specification. Thus, an amended claim thought to lack an adequate "written description" in the original disclosure should be rejected under 35 U.S.C. § 112, first paragraph.

The first paragraph of 35 U.S.C. § 112 includes, *inter alia*, the "written description" requirement and the "enablement" requirement. The written description requirement of 35 U.S.C. § 112, first paragraph, is separate from the enablement requirement found in the same provision of 35 U.S.C. § 112. Vas-Cath Inc. v. Mahukar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); In re Wilder, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). The question is not whether the hypothetical person of ordinary skill in the art could prepare what is now being claimed from the earlier disclosure but whether the earlier disclosure necessarily describes what is now being claimed. Martin v. Mayer, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987).

One of the functions of the "written description" requirement of 35 U.S.C. § 112, first paragraph, is to ensure that appellants had possession, as of the filing date of the application relied on, of the subject matter later claimed by

them. In re Blaser, 556 F.2d 534, 537, 194 USPQ 122, 124, 125 (CCPA 1977). The inquiry into satisfaction of the "written description" requirement is factual and depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Satisfaction of the "written description" requirement does not require *in ipsius verbis* antecedence in the originally filed application. In re Lukach, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The question, therefore, is whether an earlier filed application would have reasonably conveyed to a person of ordinary skill in the art that applicants invented the subject matter later claimed by them in a subsequently filed application, including the limitations in question. In re Smythe, 480 F.2d 1376, 1382, 178 USPQ 279, 284 (CCPA 1973).

Our reviewing court has recently addressed the issue of what constitutes an adequate "written description" of an invention in an earlier application for an invention claimed in a later filed application in their opinion in Purdue Pharma L.P. v. Faulding Inc., 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483, 1486 (Fed. Cir 2000). Therein, on the question of whether an originally disclosed genus served to describe a later claimed single compound within the genus, the court reaffirmed that while satisfaction of the "written description" requirement of the

statute does not require *in haec verba* support for the subject matter claimed at issue, the disclosure must "convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention." (citations omitted). The court further explained that "[p]ut another way, one skilled in the art, reading the original disclosure, must "immediately discern the limitation at issue" in the claims." (citations omitted). The court recognized that the inquiry was factual and decided on a case-by-case basis. The direction leading one to the later claimed subject matter must be expressed in "full, clear, concise and exact" language in appellants' original disclosure. See Fields v. Connover, 443 F.2d 1386, 1391, 170 USPQ 276, 280 (CCPA 1971); In re Albrecht, 435 F.2d 908, 911, 168 USPQ 293, 296 (CCPA 1971); Ruschig; 379 F.2d at 996, 154 USPQ at 123. It should be apparent from these diverse decisions that the issue of satisfaction of the written description requirement of 35 U.S.C. § 112, first paragraph, is highly fact dependent.

It is the examiner's burden to *prima facie* establish failure to comply with the written description requirement. In re Edwards, 568 F.2d 1349, 1354, 196 USPQ 465, 469 (CCPA 1978) ("The burden of showing that the claimed invention is not described in the application rests on the PTO in the first instance, and it is up to the PTO to give reasons why a description not in *ipsis verbis* is insufficient" (citations omitted). Here, we find that

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the examiner has met his burden of persuasion with respect to claim 24 but not with respect to claims 40 through 42.

Original claims constitute part of the original disclosure of a patent application. See In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397 (CCPA 1973); In re Anderson, 471 F.2d 1237, 1238, 1239, 176 USPQ 331, 332 (CCPA 1973); In re Myers, 410 F.2d 420, 427, 161 USPQ 668, 673 (CCPA 1969). Thus, claims 40 through 42, which are original claims, serve as a "written description" of the subject matter therein claimed under the first paragraph of § 112. This is true despite the fact that appellants do not disclose or exemplify any "oxidants" in their disclosure. Claim 24, however, is not an original claim. Original claim 24 recited the method of claim 1 wherein the admixture "contains a polyaniline monomer, said additive and an oxidant." Amended claim 24 recites the method of claim 1 "wherein said admixture further includes monomer of said precursor, and an oxidant."

We agree with the examiner's finding that the only relevant disclosure in appellants' specification on this issue is found at page 15 in the examples. Therein, non-doped polyaniline, a "precursor to an electrically conductive polymer", is prepared by the oxidative polymerization of aniline. Polyaniline hydrochloride is precipitated from solution and neutralized and the neutralized polyaniline is filtered, washed and dried. Subsequently, in the next example, the "precursor" is added to N-

methyldpyrrolidinone (NMP). There is no disclosure which indicates that the precursor/NMP solution contains any monomer or catalyst. We agree with the examiner's implicit determination that the neutralized polymer recovered in the example would not have been expected to contain any unreacted monomer or oxidative catalyst remaining in the polymer after the treatment steps set forth in the example had been performed. Appellants' arguments ignores the fact that claim 1 requires either a non-doped electrically conductive polymer or an electrically conductive polymer not the reaction mixture from which the polymers are obtained.

THE ALTERNATIVE REJECTIONS UNDER §§ 102 & 103

Appellants argue that the rejection of claim 11 should not be sustained because no reference discloses that the products prepared according to the prior art exhibit isotopic conductivity. Appellants also argue that the prior art does not make their polymers by the same method as used by appellants. Appellants assert that the examiner has ignored limitations in claim 1 but has not identified which limitations in claim 1 the examiner has ignored. Appellants further allege that neither Han nor Cao teach the use of a solvent. We do not find any of these arguments to be persuasive.

Appellants' method as set forth in claim 1 only requires the admixing of "a solvent", "an additive" and "a polymer." In Example 6, Han "admixes" N-methyl pyrrolidinone, one of

appellants' preferred "solvents", tripropylamine, a "plasticizer" ("additive") and an electrically conductive polyaniline, "a polymer." Han also teaches partial or substantial removal of the "solvent." Cao teaches the admixing of a polyaniline polymer with xylene, "a solvent" and dodecylbenzene sulfonic acid, one of appellants' "plasticizers". Cao teaches removal of the solvent by conventional solvent removal methods.

Because appellants form an admixture from the same ingredients as used in the prior art and because appellants subject their admixture to the same processing steps, that is, admixing of the ingredients with subsequent removal of "solvent" as does the prior art, it is reasonable to conclude that appellants' method and the products obtained by appellants' method are the same. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). See also In re Spada, 911 F.2d 705, 708, 709, 15 USPQ2d 1655, 1657, 1658 (Fed. Cir. 1990) (reasonable to presume polymers were the same where the prior art and appellants used same monomers and same or similar polymerization techniques); In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) (reasonable to presume prior art products and claimed products are identical or substantially identical where they are produced by the same or substantially the same processes).

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Whether rejected under 35 U.S.C. § 102, as "anticipated" or under 35 U.S.C. § 103 as "obvious", the rationale is the same and one of the predecessors to our reviewing court has sanctioned the practice of rejecting the claims alternatively under either or both 35 U.S.C. §§ 102 and 103 where, as here, the Patent and Trademark Office (PTO) does not have the ability to prepare and compare the prior art with what is claimed. As the court held in In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433, 434 (CCPA 1977):

"Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product....Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products." [footnotes and citations omitted]

There is simply no evidence in this record which establishes that the electrically conductive polymers obtained by appellants' method is, in fact, different from what is obtained by the prior art methods of admixing electrically conductive polymers with a "solvent" and an "additive."

Accordingly, we find that the prior art on which the examiner has relied "describes" in the sense of 35 U.S.C. § 102, the process of claim 1. With respect to the examiner's alternate rejection of the claims under § 103, we note that anticipation or

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lack of novelty has been held to be "the epitome of obviousness". See In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Accordingly, we shall also affirm the examiner's rejection under § 103 on the basis of our affirmance of the rejection under § 102.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 1.196(b), we enter the following new ground of rejection. Claims 40 through 42 are rejected under 35 U.S.C. 102 or, alternatively under 35 U.S.C. § 103, as being unpatentable over Cao, Han and Ikkala.

Although we have reversed the examiner's rejection of claims 40 through 42 under 35 U.S.C. § 112, first paragraph, for reasons set forth below, we find claims 40 through 42 to be unpatentable from the prior art.

Claim 40 requires that the method of claim 1, which requires admixing a "polymer" with a "solvent" and "an additive", uses an "additive" which is an "oxidant." Although there is no disclosure in the appellants' specification of what compounds are embraced by the term "oxidant", as an original claim the terminology is literally supported and we are not free to ignore any claim limitation. Nevertheless, the only specific compounds useful as "additives" and described and identified by appellants in their disclosure are the "plasticizers" described on page 9 and claimed in claim 10. Thus, we must conclude that at least some of the

disclosed "plasticizers" in claim 10 also are "oxidants." Accordingly, based on the rationale by which we have affirmed the examiner's rejection under § 102/§ 103 above, the prior art describes a method in which electrically conductive anilines, solvents and certain compounds, including some of the same, specific compounds used in appellants' method, are "admixed." Whether named "plasticizers" or "oxidants" or "diluent" or even simply a "second material", the fact remains that appellants admix the same compounds as the prior art "admixes" and it is, therefore, reasonable to presume that appellants obtain the same materials as the prior art obtains.

Claim 41 depends on claim 7 and recites that "said material" is an oxidant. Although claim 7 recites two "materials" the "first material" is recited to be the electrically conductive polymer. Therefore, we presume that "said material" in claim 41 is not a reference to the "first material" in claim 7. Claim 42 depends on claim 12 which recites the addition of a plasticizer and claim 42 requires that the "plasticizer" is "an oxidant."

Elsenbaumer describes the formation of an admixture of a polyaniline (column 2, line 66 through column 6, line 50); an "oxidizing dopant" (column 6, line 51 through column 8, line 3) and a solvent, such as NMP (column 8, lines 4 through 51). The solvent is removed from the admixture by "any conventional solvent removal method" (column 9, lines 54 through 61). Post

solvent removal processing, such as film casting and extrusion are disclosed (column 9, line 62 through column 10, line 48).

Claims 1, 2, 6 through 9, 15, 16, 20, 22, 40 and 41 are rejected as being unpatentable under 35 U.S.C. § 102 from the disclosure of Elsenbaumer³, or, alternatively, as unpatentable under 35 U.S.C. § 103 as being unpatentable over the disclosure in Elsenbaumer. Elsenbaumer describes a method for preparing processible forms of electrically conductive polyaniline polymers by admixing an electrically conductive polyaniline with an "additive", which is an oxidant, and a solvent, such as NMP. This is what appellants' claims require. The products of appellants' process would be expected to have the properties of Elsenbaumer's process because appellants treat the same materials to the same steps as Elsenbaumer.

SUMMARY

The rejection of claim 24 under 35 U.S.C. § 112, first paragraph, is affirmed. The rejection of claims 40 through 42 under 35 U.S.C. § 112, first paragraph, is reversed. The rejection of claims 1 through 16, 20, 22, 23 and 25 under 35 U.S.C. § 102 or, alternatively, under 35 U.S.C. § 103 is affirmed. We have made new grounds of rejection under 37 C.F.R. § 1.196(b).

³ A copy of Elsenbaumer is attached to this decision.

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The decision of the examiner is affirmed-in-part.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to

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preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to us for final action on the affirmed rejection, including any timely request for reconsideration thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART

37 C.F.R 1.196(b)

Edward C. Kimlin

EDWARD C. KIMLIN)
Administrative Patent Judge)

Andrew H. Metz

ANDREW H. METZ)
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